

REMARKS

Summary of the Office Action

Claims 1-19 are currently pending. In the Office Action mailed November 25, 2009 the Examiner rejected claims 1-19 under 35 U.S.C. §103(a), as being unpatentable over Harada et al. (U.S. Patent 5,522,466) or U.K. Patent Application 2 171 045 (hereinafter U.K. Application '045) in view of Leining (U.S. Patent 4,653,150). Applicant respectfully disagrees that that which is called for in the pending claims is remotely suggested by the art of record.

Prior Art Rejections

The Examiner rejected claims 1-19 as being unpatentable over either Harada et al. or U.K. Application '045 in view of Leining. Generally unrelated to the vibration dampening of hand tools as disclosed in the present application and Harada et al. and U.K. Application '045, Leining discloses an apparatus for the splitting of animal carcasses. Applicant fails to see how an automated carcass splitting apparatus as disclosed in Leining is analogous to hand tool vibration dampening systems as called for in the present claims. There is no disclosure or remote suggestion in Leining that the roller and rail configuration disclosed therein is suitable for vibration isolation.

As stated in MPEP §2141.01(a), “Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. ..., ..., 82 USPQ2d 1385, 1397 (2007). The

present invention is directed to isolating a tool handle from tool vibration in a manner that does not otherwise interfere with movement of portions of the tool in a working direction. The system of Leining is directed to allowing lateral translation of animal carcasses relative to a cutting station. There is no disclosure or remote suggestion in Leining for controlling vibration propagation with the roller assemblies disclosed therein. Even under the interpretation of the KSR decision, the system of Leining is devoid of any disclosure related to either of the field of endeavor of the present invention or resolution of the problem resolved by Applicant’s contribution to the art. Accordingly, Applicant believes that Leining is non-analogous art.

As stated §2143.01III, “The mere fact that references can be combined or modified does not render the resultant combination obvious....” Citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007); (*Emphasis in original*). Such guidance does not alter the requirement that “The proposed modification cannot change the principle of operation of a reference.” MPEP §2143.01V. As stated therein, “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *Id. (emphasis added)*. Even assuming arguendo that one skilled in the art would be motivated to combine the teaching of Leining with either of Harada or U.K. Application ’045, such a combination improperly changes the principles of operation of the prior art systems. The Examiner is simply trying to force too many square reference pegs into the round holes of the pending claims.

Each of claims 1 and 16 defines a percussion tool that has a number of roller elements. Claims 1 and 16 also define the interaction of the roller elements with the underlying tool and do so in a manner that is not disclosed or remotely suggested in the art of record. Claim 1 calls for that the rolling elements are disposed between the hammer housing and the handle device are supported by an axle that is attached to one of the hammer housing and the handle device. In a similar manner, claim 16 calls for, in part, that each roller is associated with an axis of rotation that is positionally fixed with respect to one of the handle cover and the hammer housing between which the rollers are positioned. Although Applicant does not necessarily disagree that the carcass splitting apparatus of Leining includes a number of roller elements that are supported by axles, combining this disclosure of Leining with the system of either of Harada et al. or U.K. Application ’045 impermissibly changes the principles of operation of the devices of these devices.

Harada et al. discloses a vibration dampening structure that allows limited translation of handle 2 relative to tool body 1. Harada et al. discloses that a number of rolling elements 4 are captured between elastic dampening members 5 and 6. Harada et al. further discloses that the rolling elements 4 are not supported by an axle or other support structure and are captured between the dampening members 5, 6 so that dampening members 5, 6 translate relative to one another thereby allowing rolling elements 4 to translate relative to inclined surfaces 13 and 15 of

dampening members 5 and 6. C. 3, l. 59 to c. 4, l. 1. That is, Harada et al. discloses that rolling elements 4 are moveable relative to both of the adjacent capturing structures. As such, not only does Harada et al. not disclose providing an axle for supporting the rolling elements, but teaches away from such a construction in disclosing that the rolling elements 4 can roll relative to inclined surfaces 13 and 15. The Examiner's combination of Leining with Harada et al. 1) disregards this express disclosure of the reference and 2) alters the principle of operation of the device of Harada et al. by impermissibly limiting the motion of rollers 4 relative at least one of the dampening members 5, 6. Accordingly, Applicant believes that the rejection of claim 1 as being unpatentable over Harada et al. in view of Leining is unsupportable. Accordingly, Applicant believes claim 1, and the claims that depend therefrom, are patentable over Harada et al. in view of Leining.

A similar shortcoming in the Examiner's reasoning exists with respect to claim 16. As rolling elements 4 of Harada et al. are moveable along each of inclined surfaces 13 and 15, Harada et al. does not disclose or remotely suggest associating rolling elements with an axis of rotation that is positionally fixed with respect to at least one of a hammer housing and a handle device as defined by claim 16. Although the unrelated system of Leining includes rollers that are positionally fixed with respect to tracking carriage 17, fixing the position of the rollers 4 of Harada et al. with respect to either of dampening members 5, 6, impermissibly changes the principle of operation of Harada et al. that rollers 4 be moveable relative to both of member 5, 6. Accordingly, Applicant believes claim 16, and the claims that dependent therefrom, are also patentable over Harada et al. in view of Leining.

As alluded to above, U.K. Application '045 discloses a tool assembly somewhat similar to that disclosed by Harada et al. for isolating transmissions of vibrations between a percussion tool and a handle. The system of U.K. Application '045 also includes a number of rollers that operate in a manner unlike the present invention. Rollers 7 of U.K. Application '045 are movable in outward directions relative to a longitudinal axis of tool 1 and handle 2. Rollers 7, as well as the axle and axis of rotation of rollers 7, must be movable relative to tool 1 and handle 2. If either the axis of rotation or the position of rollers 7 were fixed relative to tool 1 or handle 2, as suggested by the Examiner via the combination of the disclosure of Leining, the rigid connection associated with links 5 would prevent longitudinal translation between tool 1 and

handle 2. Accordingly, the Examiner's interpretation of the combination of the disclosures of Leining and U.K. Application '045 would both alter the principle of operation of the device of U.K. Application '045 and render the device of U.K. Application '045 unsuitable for it's intended purpose of allowing damped motion between the handle and tool as facilitated by the assemblies defined in current claims 1 and 16. Therefore, Applicant believes claims 1 and 16, and the claims that depend therefrom, are patentably distinct over U.K. Application '045 in view of Leining.

Therefore, for the reasons set forth above, Applicant believes claims 1-19 are patentably distinct over the art of record. Accordingly, Applicant respectfully requests a notice of allowance of claims 1-19. Although no fees are believed due for entry and consideration of this communication, the Director is authorized to direct payment of any necessary fees, or credit any overpayment, to Deposit Account No. 50-1170. The Examiner is cordially invited to contact the undersigned if any informal matters remain which may hinder or otherwise delay passage of this matter to issuance.

Respectfully submitted,



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